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PATENT
Attorney Docket No.:S-3-1

Commissioner for Patents,
Alexandria, VA 22313-1450

On Aug 20, 2003

By Katie Zarzana

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Ronald A. Underwood et al.

Application No.: 09/512,742

Filed: February 24, 2000

For: **METHODS FOR ELECTROSURGICAL
TISSUE CONTRACTION WITHIN THE SPINE**

Examiner: Lee S. Cohen

Art Unit: 3739

**INFORMATION DISCLOSURE
STATEMENT UNDER
37 CFR §1.97 and §1.98**

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

The references cited on attached form PTO-1449 are being called to the attention of the Examiner. A copy of each is enclosed.

It is respectfully requested that the cited information be considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue there from.

Applicant also brings the following information and list of materials to the attention of the Examiner. On February 13, 1998, ArthroCare Corporation filed a lawsuit in the United States District Court for the Northern District of California against defendants Ethicon, Inc., Mitek Surgical Products, Inc., and Gynecare, Inc. alleging infringement of U.S. Patent Nos. 5,697,909, 5,697,536, 5,697,281, and 5,697,882 (the "patents-in-suit"). The case was assigned Case No. C98-00609 WHO.

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The litigation terminated in June 1999, with the defendants taking a license from ArthroCare under the patents-in-suit. The defendants have paid ArthroCare a license fee, and will pay ongoing royalties on sales in the United States of certain arthroscopy and gynecology products covered by these patents.

After the litigation terminated, applicants were apprised by a third party of section 2001.06(c) of the Manual of Patent Examining Procedure ("MPEP") with respect to the prosecution of applications for patents other than those at issue in the litigation and that were pending before the litigation was commenced, namely, U.S. Application Nos. 08/807,111 (now U.S. Patent No. 5,891,095), 08/766,382 (now U.S. Patent No. 5,888,198), and 08/760,768 (now U.S. Patent No. 5,766,153).

Having considered MPEP section 2001.06(c) following receipt of the correspondence from the third party, Applicant does not believe that MPEP section 2001.06(c) requires the disclosure of the above-described litigation or any materials related to that litigation in the present application. Applicant further does not believe that MPEP section 2001.06(c) required such disclosure in connection with any other applications that were pending after the litigation commenced. Among other things, the subject matter (*i.e.* the inventions recited in the claims) of this application and the other pending applications was not at issue in the litigation.

Nevertheless, applicant did bring the above-described litigation to the attention of Examiner Mendez during the prosecution of at least U.S. Application Nos. 08/807,111 (now U.S. Patent No. 5,891,095), 08/766,382 (now U.S. Patent No. 5,888,198), and 08/795,686 (now U.S. Patent No. 5,871,469), during a telephone conference relating to those applications. Applicant also submitted the prior art that was principally relied on by the defendants in the litigation to Examiner Mendez during the prosecution of U.S. Application Nos. 08/807,111 (now U.S. Patent No. 5,891,095), 08/766,382 (now U.S. Patent No. 5,888,198), and 08/795,686 (now U.S. Patent No. 5,871,469). Indeed, Applicant withdrew one of those pending applications, U.S. Application No. 08/807,111 from allowance to provide Examiner Mendez with the opportunity to consider those references.

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In addition, Applicant provides the following list of materials from the litigation that reflect defendants' and ArthroCare's primary arguments relating to issues of validity and enforceability. Copies of item nos. 16 and 40 are attached.

1. ArthroCare's Complaint For Patent Infringement Of U.S. Letters Patent Nos. 5,697,909; 5,697,281; 5,697,882; and 5,697,536 filed February 13, 1998;
2. Plaintiff ArthroCare's Motion For Preliminary Injunction Against Defendant Ethicon and Mitek, filed March 10, 1998.
3. Answer and Counterclaim Of Defendants Ethicon, Inc., Mitek Surgical Products, Inc., and Gynecare, Inc., filed April 6, 1998;
4. Plaintiff ArthroCare's Motion To Strike Affirmative Defenses And To Strike Defendants' Counterclaim In Part Or, In The Alternative, For a More Definite Statement, filed April 17, 1998;
5. Defendants' Opposition To ArthroCare's Motion To Strike Affirmative Defenses And To Strike Defendants' Counterclaim In Part Or, In The Alternative For A More Definite Statement And Points And Authorities In Support Of Conditional Motion To File An Amended Answer and Counterclaim, filed May 7, 1998;
6. ArthroCare's Reply In Support of Motion To Strike Affirmative Defenses And To Strike Defendants' Counterclaim In Part Or, In The Alternative, For A More Definite Statement, filed May 14, 1998;
7. Memorandum Decision And Order Regarding ArthroCare's Motion To Strike And Defendants' Motion For Leave To File An Amended Answer And Counterclaim, issued June 5, 1998;
8. Amended Answer And Counterclaim of Defendants Ethicon, Inc., Mitek Surgical Products, Inc., and Gynecare, Inc., filed June 22, 1998;
9. ArthroCare's Reply to Defendants' Amended Counterclaim, filed July 6, 1998;
10. ArthroCare's Initial Disclosure Of Asserted Claims Pursuant To Local Rule 16-7, served March 30, 1998;
11. Defendants' Initial Disclosure of Prior Art Pursuant To Local Rule 16-7, served May 26, 1998;

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12. Plaintiff ArthroCare's Corporation's Opening Claim Construction Brief, filed May 11, 1998;
13. Ethicon, Inc.'s Claim Construction Brief, filed May 22, 1998;
14. Joint Claim Construction Statement Pursuant To Civil Local Rule 16-11(b)(1) For Claim Construction Hearing, filed May 29, 1998;
15. Plaintiff ArthroCare's Corporation's Reply To Defendants' Claim Construction Brief, filed May 29, 1998;
16. Memorandum Decision And Order Regarding Claim Construction, issued July 6, 1998;
17. Defendants' Petition For Permission To Appeal Pursuant To 28 U.S.C. § 1292(b) filed with the U.S. Court of Appeals for the Federal Circuit on July 16, 1998;
18. Plaintiff's Answer To Defendants' petition For Permission To Appeal Pursuant To 28 U.S.C. § 1292(b), filed July 23, 1998;
19. Federal Circuit's Order On Petition For Permission To Appeal, issued August 20, 1998;
20. Summary Of Defendant Ethicon's Opposition To Plaintiff ArthroCare's Motion For Preliminary Injunction, filed July 23, 1998;
21. Ethicon's Opposition To Plaintiff ArthroCare's Motion For Preliminary Injunction, filed July 23, 1998;
22. Declaration Of John R. LaCourse In Opposition To ArthroCare's Motion For Preliminary Injunction, filed July 23, 1998;
23. Declaration Of Robert D. Tucker Filed In Support Of Ethicon's Opposition To ArthroCare's Motion For Preliminary Injunction, filed July 23, 1998;
24. Declaration Of Robert A. Armitage, Esq., Filed In Support Of Ethicon's Opposition To ArthroCare's Motion For Preliminary Injunction , filed July 23, 1998;
25. Supplemental Declaration Of Robert A. Armitage, Esq., In Support of Ethicon's Opposition To Plaintiff ArthroCare's Motion For Preliminary Injunction, filed August 4, 1998;

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26. ArthroCare's Reply Memorandum In Support Of Motion For Preliminary

Injunction, filed August 6, 1998;

27. Declaration Of James Doss In Support Of ArthroCare's Motion For Preliminary

Injunction, filed August 6, 1998;

28. Reply Declaration Of Philip E. Eggers In Support Of ArthroCare's Motion For

Preliminary Injunction, filed August 6, 1998;

29. Reply Declaration Of John T. Raffle In Support Of ArthroCare's Motion For

Preliminary Injunction, filed August 6, 1998;

30. Ethicon's Supplemental Opposition To Plaintiff ArthroCare's Motion For

Preliminary Injunction, filed September 3, 1998.

31. Supplemental Declaration Of Robert D. Tucker, Ph.D. M.D., Filed In Support Of

Ethicon's Opposition To ArthroCare's Motion For Preliminary Injunction, filed
September 3, 1998;

32. Supplemental Declaration Of John R. LaCourse, Ph.D., Filed In Support Of

Ethicon's Opposition To ArthroCare's Motion For Preliminary Injunction, filed
September 3, 1998;

33. Direct Examination Of Robert D. Tucker, Ph.D., M.D., Filed In Support Of

Ethicon's Opposition To ArthroCare's Motion For Preliminary Injunction; filed
September 3, 1998;

34. Direct Examination of Robert A. Armitage, Esq., Filed In Support Of Ethicon's

Opposition To ArthroCare's Motion For Preliminary Injunction, filed September 3,
1998;

35. Direct Examination of John R. LaCourse, Ph.D., Filed In Support of Ethicon's

Opposition To ArthroCare's Motion For Preliminary Injunction, filed September 3,
1998;

36. ArthroCare's Supplemental Memorandum In Response To The Supplemental

Declaration Of Robert A. Armitage, filed September 3, 1998;

37. Direct Testimony Of John T. Raffle In Support Of ArthroCare's Motion For

Preliminary Injunction, filed September 3, 1998;

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38. Direct Testimony Of Philip E. Eggers In Support Of ArthroCare's Motion For Preliminary Injunction, filed September 3, 1998;
39. Joint Statement Regarding Differences Between The Two Translations Of The Elsassner And Roos Article Proffered By Defendants, filed September 22, 1998;
40. Memorandum Decision And Order Regarding Preliminary Injunction Motion, issued December 2, 1998;
41. Ethicon's Response To ArthroCare's First Set of Interrogatories To Defendant Ethicon, served November 6, 1998;
42. Plaintiff ArthroCare's Response To Defendant Gynecare, Inc.'s First Set Of Interrogatories, served November 10, 1998;
43. Plaintiff ArthroCare's Response To Mitek's First Set Of Interrogatories, served November 10, 1998;
44. Plaintiff ArthroCare's Response To Defendant Ethicon, Inc.'s First Set of Interrogatories, served November 10, 1998;
45. Plaintiff ArthroCare's Objections And Responses To Defendants' First Set Of Requests For Admissions, served January 4, 1999;
46. Plaintiff ArthroCare's Objections and Responses To Defendant Gynecare, Inc.'s Second Set Of Interrogatories, served January 4, 1999;
47. Plaintiff ArthroCare's Supplemental Objections and Responses to Defendants' Request For Admission No. 36, served January 5, 1999;
48. Expert Witness Report of John R. LaCourse, served January 8, 1999;
49. Expert Witness Report of Robert D. Tucker, served January 8, 1999;
50. Expert Witness Report of David J. Parins, served January 8, 1999;
51. Expert Witness Report of Robert A. Armitage, Esq., served January 8, 1999;
52. Expert Witness Report of Massoud Motamedi, Ph.D., served January 8, 1999;
53. Expert Witness Report of Ashley J. Welch, Ph.D., served January 8, 1999;
54. Responsive Expert Report of Leslie A. Geddes, Ph.D., served January 29, 1999;
55. Responsive Expert Report of Donald W. Banner served January 29, 1999;
56. Supplemental Expert Report of David J. Parins served February 9, 1999;

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57. Ethicon's Motion For Summary Judgment Of Invalidity For Failure To Satisfy The Requirements of 35 U.S.C. §§ 102-103, filed March 5, 1999;
58. Joint Statement Of Uncontested Facts In Support Of Ethicon's Motion For Partial Summary Judgment Of Invalidity Under 35 U.S.C. §§ 102 and 103, filed March 5, 1999;
59. Plaintiff ArthroCare's Opposition To Defendants' Motion For Summary Judgment Of Invalidity Under 35 U.S.C. §§ 102-103, filed March 18, 1999;
60. Ethicon's Reply Memorandum In Support Of Motion For Summary Judgment Of Invalidity Under 35 U.S.C. §§ 102 and 103, filed March 25, 1999;
61. Ethicon's Motion For Partial Summary Judgment Of Invalidity For Failure To Satisfy The Requirements of 35 U.S.C. § 112, filed March 5, 1999;
62. Joint Statement Of Uncontested Facts In Support of Ethicon's Motion For Partial Summary Judgment For Invalidity For Failure To Satisfy The Requirements Of 35 U.S.C. § 112, filed March 5, 1999;
63. Plaintiff ArthroCare's Opposition To Defendants' Motion For Partial Summary Judgment Of Invalidity For Failure To Satisfy The Requirements Of 35 U.S.C. § 112, filed March 18, 1999;
64. Ethicon's Reply Memorandum In Support Of Motion For Partial Summary Judgment Of Invalidity For Failure To Satisfy The Requirements Of 35 U.S.C. § 112, filed March 25, 1999;
65. Declaration of Leslie A. Geddes, Ph.D., In Support of ArthroCare's Oppositions To Defendants Motions For Partial Summary Judgment, filed March 18, 1999;
66. Plaintiff ArthroCare's Motion For Partial Summary Judgment That Claims Are Not Anticipated Or Rendered Obvious By Certain References, filed March 5, 1999;
67. Ethicon's Opposition To ArthroCare's Motion For Partial Summary Judgment That Claims Are Not Anticipated Or Rendered Obvious By Certain References, filed March 18, 1999;
68. ArthroCare's Reply Brief In Support Of ArthroCare's Motion For Partial Summary Judgment That Claims Are Not Anticipated Or Rendered Obvious By Certain References, filed March 25, 1999;

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69. Plaintiff ArthroCare's Motion For Partial Summary Judgment Of No Inequitable

Conduct Or, Alternatively, For Bifurcation, filed March 5, 1999;

70. Joint Statement Of Undisputed Facts In Support Of ArthroCare's Motion For Partial Summary Judgment Of No Inequitable Conduct Or, Alternatively, For Bifurcation, filed March 5, 1999;

71. Ethicon's Opposition Of Plaintiff ArthroCare's Motion For Partial Summary Judgment Of No Inequitable Conduct Or Alternatively For Bifurcation, filed March 18, 1999;

72. Declaration of Robert A. Armitage, Esq., In Support Of Defendant Ethicon, Inc.'s Opposition To ArthroCare's Motion For Summary Judgment, filed March 18, 1999;

73. Plaintiff ArthroCare's Reply Brief In Support Of Its Motion For Partial Summary Judgment Of No Inequitable Conduct Or, Alternatively, For Bifurcation, filed March 25, 1999;

74. Plaintiff ArthroCare's Motion For Partial Summary Judgment That Defendants Cannot Prevail On Their Enablement And Written Description Defenses As To Certain Claims, filed March 5, 1999;

75. Joint Statement Of Undisputed Facts In Support Of ArthroCare's Motion For Partial Summary Judgment That Defendants Cannot Prevail Under Enablement And Written Description Defenses As To Certain Claims, filed March 5, 1999;

76. Ethicon's Opposition To ArthroCare's Motion For Partial Summary Judgment That Defendants Cannot Prevail On Their Enablement And Written Description Defenses As To Certain Claims, filed March 18, 1999;

77. ArthroCare's Reply Brief In Support Of ArthroCare's Motion For Partial Summary Judgment That Defendants Cannot Prevail On Their Enablement And Written Description Defenses As To Certain Claims, filed March 25, 1999;

78. Defendants' Trial Brief On The Issues Of Unenforceability And Invalidity Under 35 U.S.C. §§ 102, 103, and 112, filed March 29, 1999;

79. Plaintiff ArthroCare's Trial Brief Re: Validity and Enforceability Of The Patents-In-Suit, filed April 7, 1999;

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80. Defendants' Notice Of Prior Art Pursuant To 35 U.S.C. § 282, filed April 9, 1999;

81. April 26, 1999 Letter From Defendants To The Court Regarding Additional Claim Construction Issues;

82. Joint Proposed Jury Instructions For Claims 46, 55, 58, 59, 61, and 62 of U.S. Patent No. 5,697,536;

83. April 30, 1999 Letter From ArthroCare To The Court Regarding Additional Claim Construction Issues;

84. Expedited Motion Of Plaintiff ArthroCare Corporation Regarding Joint Jury Instructions, filed May 13, 1999;


In addition to the above-listed materials, there are numerous other papers that were filed with the Court in connection with the above-referenced litigation. Furthermore, depositions were taken of numerous witnesses regarding validity and enforceability issues. If the Examiner desires, Applicant will submit any or all of the listed material, the other papers filed with the court, and/or transcripts of depositions to the Examiner for consideration. Applicant will also provide any additional information that the Examiner desires about the litigation or the materials described herein. Applicant respectfully requests that the Examiner advise Applicant in writing whether he wishes any additional information about the litigation or any of the litigation-related materials described herein or wishes Applicant to submit any materials to the Examiner for consideration.

The following is a list of co-pending applications, including this application, relating to the technology covered by this application:

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The Commissioner is authorized to charge the required fee to Deposit Account No.
50-0359.

Respectfully submitted,



Richard R. Batt
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8/20/03
Date

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